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EXAMINER

DANG, DUY M

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/084,708

Applicant(s)

IKENOUE ET AL.

Examiner

Duy M. Dang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/14/06.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-67 is/are pending in the application.
- 4a) Of the above claim(s) 50-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-49 and 56-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/084,408.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/17/06 & 10/4/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
2. Applicant is required to update all information with regard to all related applications listed on page 1 paragraph [0001] of the instant specification.

Response to Arguments

3. Applicant's arguments filed on August 14, 2006 have been fully considered but they are not persuasive.

In reply to Applicant's arguments as set forth in pages 2-5 with regard to patent '491 and Udagawa, it is noted that Applicant's argument is based on the ground that neither patent '491 nor Udagawa provide any suggestion related to copyright information. The examiner acknowledges such claimed "related to copyright information" is silent in the patent '491. However, the examiner is entitled to give the broadest reasonable interpretation to the language of the claims. The examiner is not limited to applicant's definition which is not specifically set forth in the claims. In re Tanaka et al., 193 USPQ, (CCPA) 1977. In this case, claim 42, for example, recites "said additional data including information in connection with a copyright of said inputted image data" (see lines 4-5 of claim 42). Thus, the "additional data" in patented claim 1 of the patent '491 is considered to be Applicant's additional data including information in connection with a copyright of said inputted image data". Furthermore, both instant application and patented 491 share the same disclosure and "additional data" has a similar

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definition by both instant application and patented '491. It is noted understandable why there is a difference.

In reply to Applicant's arguments as set forth in pages 5-7 with regard to patent '277, the examiner respectively disagrees. Applicant is reminded that the examiner is not limited to applicant's definition which is not specifically set forth in the claims. In re Tanaka et al., 193 USPQ, (CCPA) 1977. In this case, claim 42, for example, recites "said additional data including information in connection with a copyright of said inputted image data" (see lines 4-5 of claim 42). Thus, the "additional data" in patented claims 15 and 17 of the patent '277 is considered to be Applicant's additional data including information in connection with a copyright of said inputted image data" according to claims 21, 24, 26, and 46-49. For example, claim 21 of the patent '277 defines "additional data comprises a total number of pixels included in an image and said total number of pixels is extracted by the extract device which use extracted total number of pixels to decide a forged document".

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 42-49 and 56-67 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,738,491 (referred as the patent '491 hereinafter) in view of Udagawa et al. (USPN 5,363,202. Referred as "Udagawa" hereinafter).

Regarding claims 42-49 and 56-67 claim, the patented claims of the patent '491 generally teaches all that are claimed in the instant claims. For example, the instant claim 42 of the application recites: an input device for inputting image data (see line 2 of patented claim 1); an extractor for extracting...image data (see lines 3-9 of patented claim 1). While patented claim 1 of the patent '491 teaches all that are claimed in the instant claim 42 of the application, patented claim 1 fails to teach a transmitter as further required by the instant claim 42. However, using a transmitter is well known in the art as evidenced by the patent to Udagawa. Udagawa, in the same field of endeavor that of anti-forgery or watermarking, teaches transmitter (see "communication lines" shown in figure 13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a transmitter as taught by Udagawa in combination with the patented claim 1. By doing so, it would allow a broader application such as paperless environment and electronic transmission thereby to reduce time to transfer from one place to another place and enhance security.

6. Claims 42, 46, 56, 59, 62, and 65 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15 and 17 of U.S. Patent No. 5,671,277 (referred as the patent '277 hereinafter) in view of Udagawa.

Regarding claims 42, 46, 56, 59, 62, and 65 of the application, these instant claims call for a broader recitation of the invention and claims 15 and 17 of the patent '277 cover the equivalent subject matter as that of claims 42, 46, 56, 59, 62, and 65 of the instant application. Specifically, each of the limitations of claim 42, as a representative claim, of the instant application is set forth in patented claim 17 (note that patented claim 17 depends from patented claim 15 so it would include all features called for in patented claim 15 if written in independent form).

The patented claim 17 does not explicitly disclose a transmitter as further required by the instant claim 42. However, using a transmitter is well known in the art as evidenced by the patent to Udagawa. Udagawa, in the same field of endeavor that of anti-forgery or watermarking, teaches transmitter (see "communication lines" shown in figure 13). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a transmitter as taught by Udagawa in combination with the patented claim 17. By doing so, it would allow a broader application such as paperless environment and electronic transmission thereby to reduce time to transfer from one place to another place and enhance security.

7. Claims 42, 46, 56, 59, 62, and 65 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15 and 17 of U.S. Patent No. 5,671,277 (referred as the patent '277 hereinafter). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Regarding claims 42, 46, 56, 59, 62, and 65 of the application, these instant claims call for a broader recitation of the invention and claims 15 and 17 of the patent '277 cover the

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equivalent subject matter as that of claims 42, 46, 56, 59, 62, and 65 of the instant application. Specifically, each of the limitations of claim 42, as a representative claim, of the instant application is set forth in patented claim 17 (note that patented claim 17 depends from patented claim 15 so it would include all features called for in patented claim 15 if written in independent form). While patented claim 17 does not explicitly disclose a transmitter, patented claim 17 does disclose "image data received from a computer" in lines 2-3. Thus, the transmitter is inherently included in patented claim 17 in order for the image data to be received. Otherwise, the image data wouldn't have been received. Furthermore, while the patented claim 17 includes additional limitations not set forth in the representative claim 42 of the instant application, the use of transitional term "comprising" in the instant claim 42 fails to preclude the possibility of additional elements. Therefore, claim 42, as a representative claim, of the instant application fails to define an invention that is patentably distinct from patented claim 17.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy M. Dang whose telephone number is 571-272-7389. The examiner can normally be reached on Monday to Friday from 6:00AM to 2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew C. Bella can be reached on 571-272-7778. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

dmd
11/06


DUY M. DANG
PRIMARY EXAMINER